REMARKS

Claims 1-29 and 31-44 remain pending in the current Application. Claims 1, 12, 21, and 32 have been amended. Applicants submit that the amendments do not add new matter to the current Application. All the amendments herein have been made in order to clarify the claims and not for prior art reasons. Applicants also submit that (1) no amendment made was related to the statutory requirements of patentability unless expressly stated herein, and (2) no amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have argued herein that such amendment was made to distinguish over a particular reference or combination of references.

Rejection of Claims 1-29 and 31-40 under 35 U.S.C. 101

The Examiner has rejected claims 1-29 and 31-40, but has indicated that these claims would be allowable if written as computer implemented methods. Therefore, in order to further prosecution, Applicants have amended the preamble of claims 1, 12, 21, and 32 to refer to "a computer implemented method" rather than "a method." Therefore, Applicants submit that claims 1-29 and 31-40 are patentable under 35 U.S.C. 101.

Rejection of Claims 32 and 44 under 35 U.S.C. 112

The Examiner has rejected claims 32 and 44 under 35 U.S.C. 112 as being incomplete for omitting essential elements, such omission amounting to a gap between the steps. However, Applicants respectfully disagree. For example, referring to claim 32, Applicants submit that the claim is complete. That is, the steps of "partitioning the integrated circuit into at least one DCC" and "determining a dominant logic state corresponding to the at least one DCC" is not essential to claim 32. As stated in MPEP 2172.01, "a claim which omits matter disclosed to be essential to the invention as described in the specification of in other statements of record may be rejected..." However, Applicants never stated that these steps are essential to the invention. They provide one embodiment of how to arrive at a dominant logic state; however, the elements of claim 32 apply to determining leakage current regardless of how a dominant logic state is

determined. Similarly, with respect to claim 44, a computer readable medium may include those instructions to determine leakage current corresponding to a first dominant logic state and yet, may or may not include instructions for determining the dominant logic and may or may not include instructions for partitioning the integrated circuit into at least one DCC and determining a dominant logic state corresponding to the at least one DCC. Therefore, for at least these reasons, Applicants submit that claims 32 and 44 are both patentable over 35 U.S.C. 112 and thus do not omit any essential elements.

Rejection of claims 1-29 and 31-44 under 35 U.S.C. 102(a)

Applicants respectfully submit that claims 1-29 and 31-44 are patentable under 35 U.S.C. 102(a) over Sirichotiyakul et al. Applicants are submitting concurrently herewith a Declaration under 37 C.F.R. 1.132 signed by all the named inventors showing that the material relied upon in the Sirichotiyakul et al. publication to reject the pending claims is describing Applicants' own work. That is, the material relied upon to reject the pending claims is not "of another," as required to be valid art under 35 U.S.C. 102(a). Applicants submit that the signed declaration is sufficient to remove the Sirichotiyakul et al. publication as a valid 102(a) reference, thus overcoming the 102(a) rejection. (See, e.g., M.P.E.P. 706.02(b), 715.01(a), 715.01(c), and 716.10.) Therefore, Applicants submit that claims 1-29 and 31-44 are patentable under 35 U.S.C. 102(a) since Sirichotiyakul has been removed as a valid reference under 35 U.S.C. 102(a).

Conclusion

Although Applicants may disagree with statements made by the Examiner in reference to the claims and the cited references, Applicants are not discussing all these statements in the current Office Action, yet reserve the right to address them at a later time if necessary.

Applicants respectfully solicit allowance of the pending claims. Contact me if there are any issues regarding this communication or the current Application.

If Applicant has overlooked any additional fees, or if any overpayment has been made, the Commissioner is hereby authorized to credit or debit Deposit Account 502117.

Respectfully submitted,

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